

The opinion in support of the decision being entered today is not written for publication and is not binding precedent of the Board.

Paper No. 30

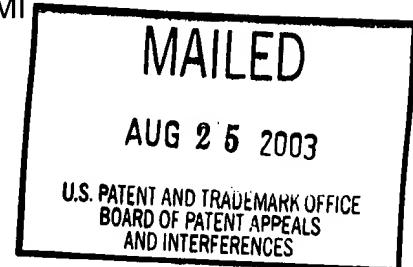
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TOHRU FUSHIKI, KENGO ISHIHARA,
TAKAHIKO ANNO, and HIRONORI TOMI

Appeal No. 2003-1059
Application No. 09/367,481

HEARD: June 12, 2003



Before WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 24-31, 40 and 41, which are all the claims pending in the application.

Claim 24 is illustrative of the subject matter on appeal and is reproduced below:

24. A method of enhancing exercise endurance in a subject undertaking exercise comprising administering to the subject a composition comprising (-)-hydroxycitric acid or a lactone form thereof, or a salt thereof, as active ingredient.

The references relied upon by the examiner are:

Lowenstein

3,764,692

Oct. 9, 1973

McCarthy, "Inhibition of Citrate Lyase May Aid Aerobic Endurance," Medical Hypotheses, Vol. 45, pp. 247-254 (1995)

GROUND OF REJECTION

Claims 24-31, 40 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lowenstein in view of Moffett, and McCarty.

For the reasons discussed below, we find Lowenstein anticipates claims 24-31, 40 and 41 under 35 U.S.C. § 102(b). Accordingly, we vacate the rejection under 35 U.S.C. § 103 in view of a new ground of rejection under 37 CFR § 1.196(b).

DISCUSSION

Claim construction:

The only required step in the method of claim 24 is the administration to a subject a composition comprising (-)-hydroxycitric acid or a lactone form thereof, or a salt thereof, as active ingredient. We recognize that the preamble of claim 24 recites "[a] method of enhancing exercise endurance in a subject undertaking exercise." According to appellants' specification (page 1), "[t]he term 'exercise endurance' is used in this specification to mean the ability to continuously perform a given physical work." Appellants' specification, however, does not define the term "exercise". To determine the "ordinary meaning" of the term "exercise," we rely on Webster's¹. Tex. Digital Sys., Inc. v. Telegenix, Inc.

¹ (Webster's) Merriam-Webster's Collegiate Dictionary, pp. 406 (10th ed., Merriam-Webster Inc., Springfield, Massachusetts, U.S.A., 1998). A copy attached of this reference is attached to the Decision.

308 F.3d 1193, 1202, 64 USPQ2d 1813, 1818 (Fed. Cir. 2002) ("dictionary definitions may be consulted in establishing a claim term's ordinary meaning"). According to Webster's, the term "exercise" means "regular or repeated use of a faculty or bodily organ." Accordingly, the term "exercise" broadly encompasses walking as is done in the normal course of daily activity.

Lowenstein:

The examiner finds (Answer, page 3), Lowenstein disclose a method of treating obesity by orally administering a composition comprising (-)-hydroxycitric acid derived from the fruit of G. cambogia as the active ingredient. Appellants have not disputed this finding as it applies to claims 24-29.

The examiner finds (id.), Lowenstein disclose the use of (-)-hydroxycitric acid "in lactone form or as a pharmaceutically acceptable salt such as the sodium or potassium salt of the acid...." Appellants have not disputed this finding as it applies to claims 24-31.

The examiner finds (id.), Lowenstein disclose that "[t]he hydroxycitric acid free acid, salt, and lactone can be administered with any pharmaceutically acceptable carrier such as water, gelatin, starch, or vegetable oil.... All of these carriers are considered food." Appellants do not dispute this findings as it applies to claims 24-31, 40 and 41.

As we understand these facts, Lowenstein discloses the single required step set forth in appellants' claimed invention, "administering to the subject a composition comprising (-)-hydroxycitric acid or a lactone form thereof, or a salt thereof, as active ingredient. Lowenstein also discloses that *Garcinia cambogia*

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is a source of (-)-hydroxycitric acid, that lactone or sodium and postassium salt forms of this acid are useful in the method, and that (-)-hydroxycitric acid or a lacton or salt form thereof can be added to food (e.g. a drink such as water, see Lowenstein, column 2, lines 26-38). Admittedly, Lowenstein does not discuss the concept of "enhancing exercise endurance in a subject undertaking exercise." However, as set forth in In re Woodruff, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936 (Fed. Cir. 1990), citations omitted, "[i]t is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable."

For the foregoing reasons it is our opinion that claims 24-31, 40 and 41 are anticipated, under 35 U.S.C. § 102(b), by Lowenstein. This is a new ground of rejection under 37 CFR § 1.196(b).

TIME PERIOD FOR RESPONSE

37 CFR § 1.196(b) provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner....

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

37 CFR § 1.196(b)

William F. Smith

William F. Smith
Administrative Patent Judge

Donald E. Adams

Donald E. Adams
Administrative Patent Judge

Lora M. Green

Lora M. Green
Administrative Patent Judge

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